

REMARKS

Claims 1-50 are pending in the present application. Applicant has cancelled claims 15 and 41, has amended claims 3, 4, 15, 16, 32, 33, 36, 41 and 46 and traverses the rejections as follows.

Response to Claim Rejections under 35 U.S.C. § 112

Claims 3, 4, 15, 16, 32, 33, 35, 36, 41, 49 and 50 appear to stand rejected under 35 U.S.C. § 112, second paragraph.¹ Applicant amends and traverses the rejections as follows.

Claims 3, 4, 35 and 36

The Examiner asserts that claims 3, 4, 35 and 36 are indefinite because they include the term “substantially free.” Applicant has amended these claims to replace the term “substantially free” with the term –free of charge—. Applicant respectfully submits that these amendments do not narrow the scope of the claims.

Claims 15, 41, 49 and 50

The Examiner asserts that claims 15, 41, 49 and 50 are indefinite because they include the term “substantially devoid.” Applicant has cancelled claims 15 and 41.

With respect to claims 49 and 50, Applicant respectfully traverses this rejection because the claims do not include the term “substantially devoid.”

Claims 16 and 33

The Examiner asserts that claims 16 and 33 are indefinite because they recite that the selected threads or content are printed in a magazine in a format “recognizably similar” to that in the online forum. Applicant has amended claims 16 and 33 to replace the term “recognizably similar” with language reciting that the format “assists readers in recognizing that” the selected threads or content are from the online forum. Applicant respectfully submits that these amendments do not narrow the scope of the claims.

¹ Although the Examiner indicates at the beginning of paragraph 2 of the Office Action that claims 3, 4, 15, 16, and 33-50 (but not 32) have been rejected, specific reasons for the rejections are given only for claims 3, 4, 15, 16, 32, 33, 35, 36, 41, 49 and 50, as well as for claim 32. Applicant therefore addresses the claims for which these specific reasons for rejection have been given. If the Examiner intended to reject additional claims under 35 U.S.C. § 112, second paragraph, Applicant respectfully requests that the Examiner specify the basis for the rejection of those claims.

Claim 32

The Examiner asserts that claim 32 is indefinite on the grounds that the recited “advertising means for making advertising in the magazine available to advertisers desiring to offer products” is not supported by structure disclosed in the specification. Applicant has amended the claim to replace the means-plus-function form of the advertising means element with a recitation that “the magazine also includes advertising of advertisers desiring to offer products to the entities in the subject area.” Applicant respectfully submits that this amendment does not narrow the scope of the claim.

Response to Claim Rejection Under 35 U.S.C. § 103(a)

Claims 1-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchida (JP 2001357142). Applicants respectfully traverse this rejection.

Applicable Standards

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must identify a reason that would have prompted a person of ordinary skill in the relevant field to modify a prior art reference to produce the claimed invention. MPEP § 2143. The reason must have some rational underpinning to support the legal conclusion of obviousness. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). One way to establish obviousness is to identify some suggestion or motivation to modify the reference to produce the claimed invention. *See* MPEP § 2142. In performing this analysis, however, the “factfinder should be aware . . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. *See also Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

Rejections based on obviousness cannot be sustained with mere conclusory statements. *Id.* § 2142. Moreover, conclusions of obviousness based on “common knowledge” and “common sense” are not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *See* MPEP § 2143.01 (Assertion that modifications of the prior art would have been “well within the ordinary skill of the art at the time the claimed invention was made” is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.)

In addition, an obviousness rejection under 35 U.S.C. § 103 requires that the prior art reference (or references when combined) teach or suggest all of the claim limitations. MPEP § 2143.03.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

General Discussion of Applicant's Invention and Tsuchida

Applicant's invention is directed to a method and system of publishing an interactive printed magazine for distribution in a business-to-business vertical market, such as dentistry or medicine. An interactive online forum, implemented via a computer network such as the Internet, is used to stimulate debate among participants in the forum. The forum addresses a subject area of interest to businesses in the vertical market. Threads from the interactive online forum are selected for printing in the magazine, which is distributed in the vertical market. The online forum threads can be ranked by popularity. Advertising is printed in the magazine for products offered in the vertical market to businesses that have an interest in the subject matter of the published threads.

In contrast to Applicant's invention, Tsuchida discloses a publishing system and method that is directed to consumer purchasers of books. The system of Tsuchida utilizes the Internet to allow consumers to post opinions, assertions and experiential accounts on a selected theme. Users are allowed to publicly present up to three themes on a declaration page. The system operator collects the themes and solicits the users' input of their opinions, assertions and experiential accounts in the form of short essays (*see* 0021). The system then outputs the users' essays to be published in a bound book (*see* 0027-29).

Tsuchida does not teach or suggest using an online forum for interactive debate among the users to generate content for a publication. Although the system of Tsuchida provides for a posting of themes, it does not provide an online forum for interactive debate on the essays input by the users about those themes. On the contrary, Tsuchida specifically teaches that the system does "not publicly present the opinions, assertions and experiences of other people over the communication network, rather publishing them together in a publication" (0046). Thus, a user of the Tsuchida system cannot see other users' essays. The goal of this is to "stimulate the sense of satisfaction of having one's own opinions, assertions, experiences, etc. included in the publication, and the interest and curiosity of wanting to find out the opinions, assertions,

experiences, etc. of other people on the theme in question, thereby strongly exciting the desire to purchase the publication” (0046). In other words, the goal of Tsuchida is to stimulate the purchase of the published book at a later date by restricting prior online exchange and debate about the users’ essays. Tsuchida, therefore, does not utilize an “online forum in a common subject area,” nor does it generate forum “threads” (*i.e.*, a series of messages in an online discussion) as does Applicant’s invention.

Tsuchida also does not teach or suggest soliciting input from users on an area of interest to businesses in a vertical market. Although Tsuchida contemplates that user’s will provide input on different themes, those themes do not teach or suggest the vertical market aspect of Applicant’s invention. A vertical market is a group of similar businesses and customers that engage in trade in a specific industry having specialized needs. Tsuchida does not teach or suggest such a use. Instead, Tsuchida teaches a system and method that allows “consumers to enjoy reading books.” (*See* 0057, Abstract). Moreover, Tsuchida does not teach or suggest printing advertising in the published book related to a specific industry. Rather, it contemplates a business model whereby revenue is generated from stimulated sales of the book as discussed above, rather than advertising revenues.

Applicant respectfully submits, therefore, that the Examiner’s suggested reasons for modifying Tsuchida to achieve Applicant’s invention are based on improper hindsight from Applicant’s disclosure.

Applicant’s claims are discussed more specifically below.

Claims 1-31

Claim 1 is directed to a method of publishing a printed magazine. The method includes: providing the magazine to a substantial portion of a vertical market comprising entities having interest in a common subject area; printing in the magazine portions of selected threads from an online forum in the subject area; and printing advertising in the magazine for at least one advertiser offering at least one product to at least some of the entities having interest in the common subject area.

Tsuchida does not teach or suggest all of the limitations recited in claim 1. For example, as discussed above, Tsuchida does not disclose “providing the magazine to a substantial portion of a vertical market.” In the Office Action, the Examiner argues that it would have been obvious to provide content for publications of any theme. Office Action at 3. As discussed above,

however, the use of themes does teach or suggest the vertical market aspect of Applicant's invention.

Nor does Tsuchida disclose printing portions of "selected threads from an online forum in the subject area" or "printing advertising in a magazine for at least one advertiser offering at least one product to at least some of the entities having interest in the common subject area." In the Office Action, the Examiner asserts that it is well known to subsidize a publication by advertising. As discussed above, however, the Tsuchida system and method teaches away from such a business model.

Applicants submit, therefore, that Tsuchida does not teach or suggest all of the elements of claim 1.

Each of claims 2-31 depends from and includes all of the limitations of claim 1. For the reasons discussed above with respect to claim 1, Applicant submits that Tsuchida also does not teach or suggest all of the elements recited in Applicants' claims 2-31.

With respect to claim 9, Tsuchida also does not teach or suggest that "the entities must demonstrate qualification in the subject area to access the online forum," as recited in the claim. Similarly, with respect to claim 10, Tsuchida also does not teach or suggest that "the entities are required to correctly answer a qualifying question in the subject area before being allowed to participate in the online forum," as recited in the claim. The Examiner asserts that it would have been obvious to require users to demonstrate qualification in the subject matter to avoid unwanted postings. Office Action at 4. Applicant respectfully disagrees because there are other means for removing unwanted postings. For example, Tsuchida teaches that the user input can be edited after it is collected (*see* 0027).

With respect to claims 11-13, Tsuchida also does not teach or suggest that "a criterion for selecting the threads from an online forum is the popularity of the threads," that "the popularity of the threads is measured by the number of thread entries" or that "the popularity of the threads is measured by the number of entities contributing to the threads," as recited in one or more of the claims. Rather, Tsuchida teaches away from measuring thread popularity because it teaches away from allowing the users to engage in any online debate that could generate threads.

With respect to claim 14, Tsuchida also does not teach or suggest that "advertising in the magazine for products related to the portions of selected threads is available to advertisers proximally to the portions of selected threads in the magazine," as recited in the claim.

With respect to claims 16-29, Tsuchida also does not teach or suggest any of the recited features regarding the selected threads.

Applicant respectfully submits, therefore, that Tsuchida does not render claims 1-31 unpatentable.

Claim 32

Amended claim 32 is directed to a system for publishing content. The system includes in combination: publishing means for providing a magazine to a substantial portion of a vertical market comprising entities having interest in a common subject area; means for obtaining from an online forum in the subject area portions of selected threads in the subject area; and content means for printing in the magazine portions of the selected threads from an online forum in the subject area. The magazine also includes advertising of advertisers desiring to offer products to the entities in the subject area.

Tsuchida does not teach or suggest all of the limitations recited in claim 32. For example, as discussed above, Tsuchida does not disclose “means for providing a magazine to a substantial portion of a vertical market.” Nor does Tsuchida disclose printing portions of “means for obtaining from an online forum in the subject area portions of selected threads in the subject area” or “means for printing in the magazine portions of the selected threads from an online forum in the subject area.” Applicant submits, therefore, that Tsuchida does not teach or suggest all of the elements of claim 32.

Applicant respectfully submits, therefore, that Tsuchida does not render claim 32 unpatentable.

Claim 33-49

Amended claim 33 is directed to a method of publishing content. The method includes, in combination, the steps of: ranking online forum threads by popularity; selecting at least one subset of popular topics for publication; editing the content of the at least one subset; and printing the content in at least one printed publication in a format that assists readers in recognizing that the content is from the online forum.

Tsuchida does not teach or suggest all of the limitations recited in claim 33. For example, as discussed above, Tsuchida does not disclose “an online forum,” or “ranking online forum threads by popularity.” Nor does Tsuchida teach or suggest “ranking online forum threads by popularity,” as recited in the claim.

The Examiner argues that it would have been obvious to select the most popular forum threads for inclusion in the publication to provide a popular publication. As discussed above, however, Tsuchida teaches away from utilizing a forum for generating any threads.

Each of claims 34-48 depends from and includes all of the limitations of claim 33. For the reasons discussed above with respect to claim 33, Applicant submits that Tsuchida also does not teach or suggest all of the elements recited in Applicants' claims 34-48 and does not render those claims obvious.

With respect to claim 40, as discussed above, Tsuchida also does not teach or suggest "advertising in the at least one printed publication for products related to the content is available to advertisers proximally to the content in the at least one printed publication," as recited in the claim.

With respect to claims 43-46 and 48, Tsuchida also does not teach or suggest any of the recited features regarding the thread information.

Applicant respectfully submits, therefore, that Tsuchida does not render claims 33-48 unpatentable.

Claim 49

Claim 49 is directed to a method of publishing content. The method includes: providing at least one online forum; selecting at least one subset of online subject matter from the at least one online forum for publication; editing the content of the at least one subset of online subject matter; and printing the content in a format recognizably similar to at least one format of the at least one subset of online subject matter.

Tsuchida does not teach or suggest all of the limitations recited in claim 49. For example, as discussed above, Tsuchida does not disclose "providing at least one online forum" or "selecting at least one subset of online subject matter from the at least one online forum for publication."

Applicant respectfully submits, therefore, that Tsuchida does not render claim 49 unpatentable.

Claim 50

Amended claim 50 is directed to a system for publishing content. The system includes, in combination: means for providing at least one online forum; means for selecting at least one subset of online subject matter from the at least one online forum for publication; means for

editing the content of the at least one subset of online subject matter; and means for printing the content in a format recognizably similar to at least one format of the at least one subset of online subject matter.

Tsuchida does not teach or suggest all of the limitations recited in claim 50. For example, as discussed above, Tsuchida does not disclose “means for providing at least one online forum” or “means for selecting at least one subset of online subject matter from the at least one online forum for publication.”

Applicant respectfully submits, therefore, that Tsuchida does not render claim 50 unpatentable.

Conclusion

Applicants respectfully submit that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore request that the Examiner reconsider all presently outstanding rejections, that they be withdrawn and that the claims be allowed. It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

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